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09/773,351	01/31/2001	Daniel H. Maes	00.22US	5974

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EXAMINER

JIANG, SHAOJIA A

ART UNIT PAPER NUMBER

1617

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/773,351

**Applicant(s)**

MAES ET AL.

**Examiner**

Shaojia A Jiang

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/7/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 7, 2004 has been entered.

This Office Action is a response to Applicant's request for continued examination (RCE) filed January 7, 2004, and amendment and response to the Final Office Action (mailed May 6, 2003), filed January 7, 2004 wherein claims 1 and 3-20 have been amended.

It is noted that claim 2 has been cancelled in Applicant's amendment filed on February 5, 2003 and recorded in the previous Office Action May 6, 2003.

Currently, claims 1 and 3-20 are pending in this application.

Claims 1 and 3-20 are examined on the merits herein.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment with respect to amended claim 1 has been fully considered but is deemed to insert new matter into the claims since the specification as originally filed does not provide support for the recitation "integral with". Nowhere in the original specification is the phrase "integral with" found. Consequently, there is nothing within the instant specification which would lead the artisan in the field to believe that Applicant was in possession of the invention as it is now claimed. See *Vas-Cath Inc. v. Mahurkar*, 19 USPQ 2d 1111, CAFC 1991, see also *In re Winkhaus*, 188 USPQ 129, CCPA 1975.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "integral with" in claim 1 renders these claims indefinite. The recitation "integral with" is not clearly defined in the specification. Hence, one of ordinary skill in the art could not ascertain and interpret the metes and bounds of the patent protection desired as to what "integral with" encompassed thereby. The recitation

"integral with" could be interpreted as "mixed with" or "a mixture of" according to its plain and ordinary meaning.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 6-9, 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ribier et al. (5,925,364, of record) in view of Sebag et al. (5,411,742, of record) for the same reasons of record in the previous Office Action May 6, 2003.

Ribier et al. discloses a cosmetic or dermatological composition comprising the ionic amphiphilic lipid such as the alkali metal salts of cholesterol sulphate in particular the sodium salt in amount of 2-6% by weight preferably 3-4% by weight (see col.3 lines 43-48 and 54-55, col.4 lines 12-15), salicylic acid (a known exfoliant) (see claim 18 at col.15 line 6), keratolytic agents (known exfoliants) (see col.5 line 36, claim 15 at col.14 line 49), fatty acids broadly (see col.4 line 60, claim 18 at col.15 line 5), and Centella asiatica extract (see col.4 line 64, claim 18 at col.15 line 8). The cosmetic or dermatological composition Ribier et al. is known to topically apply to skin.

Ribier et al. does not expressly disclose the employment of the particular fatty acid, linoleic acid, and cholesterol in the composition herein. The prior art does also not expressly disclose the amounts of an exfoliant in the composition herein.

Sebag et al. discloses a cosmetic or dermatological composition comprising the salts of cholesterol (see col.2 line 34), salicylic acid or its derivatives (known exfoliants) in amounts of 3-10% by weight (see abstract, col.3 lines 26-36), keratolytic agents (known exfoliants) (see col.6 line 66), the particular fatty acid, linoleic acid (see claim 10 at col.17 line 17), and cholesterol (see claim 8 at col.17 lines 5-6).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the particular fatty acid, linoleic acid, and cholesterol in the composition of Ribier and to optimize the effective amounts of an exfoliant in the composition herein to about 10% by weight.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the particular fatty acid, linoleic acid, and cholesterol in the composition of Ribier since fatty acids broadly and the particular fatty acid, linoleic acid, are known to be useful in a cosmetic or dermatological for of treating skin based on the prior art. Moreover, cholesterol is well known to be used a cosmetic or dermatological for of treating skin according Sebag. Therefore, one of ordinary skill in the art would have reasonably expected that combining the composition of Ribier and the composition of Sebag known useful for the same purpose, treating skin, in a composition to be administered would improve the therapeutic effect for treating skin.

Since all active composition components herein are known to be useful to treat skin, it is considered prima facie obvious to combine them into a single composition to form a third composition useful for the very same purpose. At least additive therapeutic effects would have been reasonably expected. See *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980).

Additionally, one of ordinary skill in the art would have been motivated to optimize the effective amounts of the alkali metal salts of cholesterol sulphate and an exfoliant in the composition because their amounts are known in the art and the optimization of known amounts of active agents to be administered is considered well within the skill of artisan. It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Thus the claimed invention as a whole is clearly prima facie obvious over the combined teachings of the prior art.

Applicant's arguments filed on January 7, 2004 with respect to this rejection of claims made under 35 U.S.C. 103(a) as being unpatentable over Ribier et al. (5,925,364) in view of Sebag et al. (5,411,742) of record in the previous Office Action have been considered but not found persuasive as to the nonobviousness of the claimed invention over the prior art as further discussed below.

Applicants assert that similar to Ribier et al. (5,650,166), because the two ingredients are used to form, and thus, become part of discrete layers of a lipid vesicle, the composition of Ribier et al. (5,925,364) is not an integral mixture as they are in the

present invention. However, both 5,650,166 and 5,925,364 teach an integral mixture in a stabilized oil-in-water emulsion form with no discrete layers of a lipid vesicle (see 5,925,364, the preparation of the composition therein at col.6-7). Note that the instant claims are not limited to the particular form of mixture, i.e., emulsion, gel, lotion, and ointment forms which are well known in the cosmetic art.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ribier et al. (5,650,166 of record).

Ribier et al. discloses a moisturizing composition for the treatment of surface and deep layers of the skin clear comprising the instant ingredients such as cholesterol sulfate in the salt of alkali metal (including potassium) (see col.3 lines 64-67), N-acetylglucosamine (see col. 5, lines 59-67), the particular sterol, cholesterol (see col.3 line 60 and col. 6, lines 47-49), fatty acids, including linoleic acid (see col. 6, lines 44-46). Ribier' 166 further teaches the use of plant extracts (see col. 7, lines 5-8). The compositions of Ribier et al. may be emulsion, gel, lotion, and ointment forms (see col.7 lines 10-14).

Thus, the disclosure of Ribier et al. anticipates Claims 1 and 3-9.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ribier et al. (5,650,166 of record).

The same disclosure of Ribier et al. (5,650,166) has been discussed in the 102(b) rejection set forth above.

The cited prior art does not expressly disclose that the amount of the each instant ingredient.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the amount of the known particular agents taught in Ribier et al.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the amount of the known particular agents taught in Ribier et al. since the determination or optimization of amounts of known cosmetic agents, is considered well within conventional skills in pharmaceutical science, involving merely routine skill in the art.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Applicant's remarks filed on January 7, 2004 with respect to disclosure of Ribier et al. (5,650,166) have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art as discussed above. In particular, note that the instant claims are not limited to the particular form of mixture, and moreover, Ribier et al. teaches the compositions therein for topical use in emulsion, gel, lotion, and ointment forms.

Applicant's argument that the cited Ribier et al. (5,650,166) does not teach NADG directly added to a vehicle, is not found convincing. The instant claims are not limited to specific method in a specific method steps for the preparation of the instant composition. Therefore, it is irrelevant whether the reference includes those features or not.

Claims 10-12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ribier et al. (5,650,166) further in view of Subbiah (6,150,381) and Ichinose et al. (5,702,691) for reasons of record stated in the Office Action dated November 5, 2002.

The claims are directed to compositions further comprising sclareolide and white birch extract.

The same disclosure of Ribier et al. (5,650,166) has been discussed in the 102(b) rejection set forth above.

The cited prior art does not expressly disclose the employment of sclareolide and white birch extract.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to add or employ sclareolide and white birch extract in the composition of Ribier et al.

Subbiah teaches the use of sclareolide in topical formulations, padicularly for cne (see abstract). Sclareolide is taught in combination with other ingredients (see col. 5, line 6 through col. 7, line 12). Subbiah teaches that sclareolide has antimicrobial activity that is useful in the treatment of acne (see col. 4, lines 45-65).

Ichinose teaches that white birch extracts are known anti-inflammatory agents (see col . 5, lines 4-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Ribier '166 by the addition of sclareolide for its anti-acne properties as taught by Subbiah and by the addition of white birch extract for its anti-inflammatory properties as taught by Ichinose. The motivation for the modification comes from the benefit of such propedies in formulating cosmetic compositions. The missing ingredients have art-recognized suitability for the intended purpose of formulating cosmetic compositions. The selection of a known material based on its suitability for its intended use has been determined to be prima facie obvious. See *Slhclair & Carroll Co. F. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945)., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); and MPEP 2144.07.

Applicant's remarks filed on January 7, 2007 with respect to this rejection made under 35 U.S.C. 103(a) of record stated in the Office Action dated November 5, 2002 have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art, as discussed above.

Further, Applicant's one Example shown in the specification at pages 8-10 herein have been fully considered but are not deemed persuasive as to the nonobviousness and/or unexpected results of the claimed invention over the prior art for the reasons below. Example 1 provides no clear and convincing evidence of nonobviousness or unexpected results over the cited prior art since there is no comparison to the same present. Therefore, the evidence presented in specification herein is not seen to be clear and convincing in support the nonobviousness of the instant claimed invention over the prior art.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/424,616.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the copending application and the instant application are drawn to a skin/cosmetic composition containing cholesterol sulfate, fatty acids, and a sterol (such as cholesterol) and methods employing the compositions.

Thus, the copending Application No. 10/424,616 and the instant claims are seen to substantially overlap.

Thus, the instant claims are seen to be obvious over the all claims of copending Application No. 10/424,616.


This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is 571.272.0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on 571.272.0629. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.



S. Anna Jiang, Ph.D.  
Patent Examiner, AU 1617  
March 15, 2004